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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/724,894

12/02/2003

Masaaki Konno

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04/10/2007

WHITHAM, CURTIS & CHRISTOFFERSON & COOK, P.C.

11491 SUNSET HILLS ROAD

SUITE 340

RESTON, VA 20190

EXAMINER

CHEN, BRET P

ART UNIT

PAPER NUMBER

1762

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

04/10/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/724,894

Applicant(s)

KONNO ET AL.

Examiner

B. Chen

Art Unit

1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-16 and 19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-16 and 19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

Claims 2-16, 19 are pending in this application. Amended claims 2, 7, 10, and newly added claim 19 are noted.

The amendment dated 2/21/07 has been entered and carefully considered. The examiner appreciates the amendments to the claims. In view of the amendments, the art rejection for claims 2-6, 19 have been withdrawn. In addition, in view of the properly filed Terminal Disclaimer, the obviousness double patenting rejection has been withdrawn.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**Claims 2-6, 19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.** The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claim 2, from which claims 3-6 and 19 depend from, the phrase "providing a three-dimension information identified by three-dimensional characteristics of objects represented in said two-dimensional image" is deemed new matter as there appears to be no support for same in the original specification. Applicant points out that pp. 26-37 of the specification teaches this feature (p.7 first paragraph) but the examiner is unable to locate it.

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In claim 2, the phrase “recording an image on an image recording surface, based on said image data” is deemed new matter as there appears to be no support in the original specification for this limitation. The examiner notes that there is support for recording an image on an image recording surface in applicant’s specification.

In claim 2, the phrase “forming on said image recording surface a transparent coat layer, covering an area in the image, having asperities with a form based on said three-dimensional information” is deemed new matter as there appears to be no support in the original specification for this limitation. The examiner notes that there is support for forming a transparent coat layer which has asperities on an image recording surface in applicant’s specification.

**Claims 2-6, 19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.** The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In claim 2 lines 6-7, from which claims 3-6 and 19 depend from, the applicant requires “recording an image on an image recording surface, based on said image data”. The specification does not enable one skilled in the art how an image is to be recorded depending on the image data. For example, if the image data is A, then X is done and if image data is B, then Y is done. There is simply no teaching in the specification which enables the skilled artisan how to perform the claimed invention.

In claim 2 lines 8-10, from which claims 3-6 and 19 depend from, the applicant requires “forming on said image recording surface a transparent coat layer, covering an area in the image,

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having asperities with a form based on said three-dimensional information". For the same reasons mentioned above, the specification does not enable one skilled in the art how a transparent coat layer is to be formed based on the three-dimensional information. For example, if the 3-d information is A, then X is done and if the 3-d information is B, then Y is done. There is simply no teaching in the specification which enables the skilled artisan how to perform the claimed invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

In claim 19, the phrase "wherein the three-dimension information includes surface properties of said objects" is deemed vague and confusing. It is not clear how a three dimension information includes surface properties of said objects. It is noted that paragraph 68 of applicant's specification does not clarify this issue.

***Claim Rejections - 35 USC § 102-103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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**Claims 7-16 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Fujiwara et al. (4,977,136) for the reasons listed in the previous office action.**

***Response to Arguments***

Applicant's arguments filed 2/21/07 have been fully considered but they are not persuasive.

Applicant first argues that Fujiwara fails to teach a cover film which has asperities (p.10 last paragraph); fails to teach formation on a designated area (p.11 first paragraph); fails to teach forming said asperities (p.11 second paragraph); and fails to teach "shape data".

The examiner disagrees. It is noted that Fujiwara teaches making a cover film for hard copy printing paper by forming a transparent protecting layer on the surface of a printing paper which has a color picture image is printed. Applicant has not taken issue with this. The examiner has taken the position that the whatever contours the image has would inherently be translated to the protective layer. Simply put, the profile of the protection layer would take on the profile of the image. Thus the asperities and the shape data from designated areas of the image would be passed on to the protective layer.

Applicant next argues that Fujiwara fails to teach analyzing to detect a density variation and failing to teach forming a transparent coating layer having asperities corresponding to the detected density variation (pp.11-12).

The examiner agrees in part. As stated in the previous office action, Fujiwara does not teach an analysis step. Motivation has been provided by the examiner of incorporating same

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with the expectation of obtaining a precise coating. In addition, asperities are a result of and/or are density variations and thus, have been addressed above.

Applicant's arguments have been considered but are not deemed persuasive.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to B. Chen whose telephone number is (571) 272-1417. The examiner can normally be reached on 7:30am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Bc  
4/8/07



**BRET CHEN**  
**PRIMARY EXAMINER**